

Remarks / Arguments

Election/Restrictions

The Applicant acknowledges the withdrawal from consideration of claims 27-37, without prejudice to the Applicant's right to file a divisional application.

Amendments to the Claims

The Applicant has amended claim 1 to more clearly indicate that the specific scoring area comprises a portion of the general scoring area remaining uncovered by the one or more blocking pieces, and that the scoring pieces are distinct from the blocking pieces. It is respectfully submitted that the amended claim is supported by the disclosure, for example paragraph 4, which provides that "the uncovered portions of the general scoring area are defined as a specific scoring area", and by (for example) paragraphs 23 and 24, referring to blocking piece having a "goaltender" imprinted thereon, and to a scoring piece having a "hockey player" imprinted thereon, and to Figures 1b and 1c showing them to be distinct in appearance.

Similarly, the Applicant has amended Claim 20 to more clearly indicate that the specific scoring area comprises a portion of the general scoring area remaining uncovered by the blocking piece.

The Applicant has added claims 38 and 39 which correspond to previously canceled claims 25 and 26. These claims properly depend from claim 20 and add additional structural limitations to the invention of claim 20. These claims are patentable for the same reasons set out below in respect of claim 20.

Claim Rejections – 35 U.S.C. §102

As a preliminary matter, the Applicant notes that the Examiner has rejected the Applicant's earlier arguments as unpersuasive because they relate to playing the game rather than to limitations of the claimed apparatus. The Examiner's attention is

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respectfully directed to *Marvin Glass & Associates v. De Luxe Topper Corporation* (1967), 284 F. Supp. 558, a decision of the United States District Court for the Southern District of New York, in which the Court indicated that the manner of interaction between game pieces was relevant to patentability of the claims and distinguishing between the claims and alleged infringing games in issue in that case.

The Examiner has rejected claims 1, 5-10 and 16-19 as being anticipated by O'Grady (U.S. Patent 4,305,587). As noted above, the Applicant has amended claim 1, and submits that these amendments address any anticipation concerns.

The Applicant respectfully submits that although O'Grady does not teach the use of "blocking pieces" as described in the Applicant's invention. In particular, at column 3, lines 17 to 19, O'Grady provides:

... If one disc completely overlaps the smaller concentric circle of another disc, the score awarded by virtue of playing the first disc could be cancelled.

Similarly, at column 3, line 57 to column 4, line 3, O'Grady states as follows:

The discs in the lower right hand corner of the target board would not receive any score since the second or upper disc totally overlaps the smaller concentric circle of the lower disc, thereby canceling out any score the first or lower disk may have been entitled to.

As can be seen from the above quotations, while one disc may overlap another, the first disc does not thereby become a "blocking piece", because the overlapping disc will still score, albeit in a different way. Such an overlapping disc will cancel the score of an underlying disc, which is nonetheless a way of scoring (i.e. it widens or narrows the point gap between those two players).

Furthermore, O'Grady does not disclose blocking pieces that are distinct from the scoring pieces (as described in the amended claim), but discloses only scoring pieces

(i.e. the discs). Even if a disc is viewed as having the effect of "blocking" another disc, it is still a scoring piece, since it will have scored points (which points may be cancelled if an overlapping disc lands on top of the scoring piece).

The applicant respectfully submits that claim 1, as amended, is not anticipated by O'Grady and is patentable thereover. Furthermore, since claims 2-9 and 16-19 are dependent on claim 1, the Applicant respectfully submits that these claims are patentable over O'Grady for the same reasons as claim 1.

The Examiner has objected that claim 20 is anticipated by Christian (U.S. Patent Number 6,131,905). The Applicant has amended claim 20, and submits that claim 20, as amended, is not anticipated by Christian.

Claim 20 (both as originally filed and as amended) requires "receiving pieces" to define a general scoring area, "blocking pieces for positioning on said game board to define one or more specific scoring areas", and has been amended to specify that the general scoring area is on a surface of the receiving piece, and that the "one or more specific scoring areas comprise at least one portion of said one or more general scoring areas remaining uncovered by said one or more blocking pieces". The Applicant respectfully submits claim 20 is now patentable over Christian.

The Examiner has construed container 14 of Christian as being a "receiving piece". This is not correct, especially in the context of the present application. Christian describes points being scored by tossing a marker "closer to a center piece, without contacting the centerpiece", or by "rounding" the centerpiece. Thus, the general scoring area will be on the regions surrounding the cylinder 14, and not on the surface of cylinder 14 itself. Furthermore, Christian does not disclose any circumstance in which the surface of cylinder 14 would be "covered". Christian's container 14 is not a receiving piece or a scoring area as that term is used in the (amended) claim, which refers to a general scoring area defined on the surface of the receiving piece(s).

In the particular case of "rounding", scoring is not defined by reference to a "scoring area" at all, but rather by the path taken by the disc. Specifically, a disc coming

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to rest in contact with the surface of cylinder 14 will not score any points simply by coming to rest in that area, unless it had properly "rounded" the cylinder 14 first. Furthermore, in the case of points scored by making chains of discs beginning with a disc that had "rounded", it will be noted that any "specific scoring area" is not defined by portions of the surface of the cylinder remaining uncovered.

In addition, the Applicant respectfully disputes the Examiner's contention that Christian discloses "blocking pieces". In particular, Christian states specifically that points may be awarded "for knocking other player's markers away". If colliding with another player's marker causes points to be awarded, that marker cannot be said to be a "blocking piece", since it does not truly "block", but rather provides an additional target.

For the reasons outlined above, therefore, the Applicant respectfully submits that claim 20, as amended, is patentable over Christian.

Claim Rejections – 35 U.S.C. §103

The Examiner has also objected that claims 11-16 are unpatentable over O'Grady in view of Stuart (U.S. Patent Number 4,055,343), which the Examiner has cited only for the addition of hook and loop attachment means. As noted above, the Applicant submits that claim 1 as amended is patentable over O'Grady. Since claims 11-16 depend either directly or indirectly from claim 1, it is respectfully submitted that these claims are patentable over O'Grady in view of Stewart.

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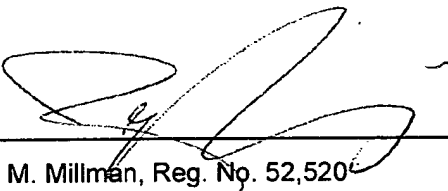
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Conclusion

In view of the foregoing comments, it is respectfully submitted that the application is now in condition for allowance. If the Examiner has any further concerns regarding the language of the claims or the applicability of the prior art, the Examiner is respectfully requested to contact the undersigned at 416-957-1679.

Respectfully submitted,

John MacEachern



A handwritten signature in black ink, appearing to read 'Jay M. Millman', is written over a horizontal line.

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